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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,275	12/30/2003	Robert A. Luciano	10407/989	9180

30076   7590   09/06/2006

BROWN RAYSMAN MILLSTEIN FELDER & STEINER, LLP
1880 CENTURY PARK EAST
12TH FLOOR
LOS ANGELES, CA 90067

EXAMINER
HSU, RYAN

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/750,275	LUCIANO ET AL.
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 May 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-20,23-31,33-37,39-41 and 43-46</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-20,23-31,33-37,39-41 and 43-46</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119.

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

In response to the Request for Continued Examination (RCE) under 37 CFR 1.114 filed

on 5/8/06. Claims 2, 21, 22, 32, 38 and 42 have been canceled without prejudice and claims 1,

20, 33, and 41 have been amended. Claims 1, 3-20, 23-31, 33-37, and 39-46 are currently

pending in the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection
is appropriate where the conflicting claims are not identical, but at least one examined
application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference
claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re
Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re
Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
ground provided the conflicting application or patent either is shown to be commonly owned
with this application, or claims an invention made as a result of activities undertaken within the
scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
3.73(b).

Claims 1, 20, 33 and 41 are rejected on the ground of nonstatutory double patenting over

claims 1-6 of U. S. Patent No. 6,685,559 B2 (herein referred to as '559) since the claims, if

allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is

covered by the patent since the patent and the application are claiming common subject matter,

as follows: Claims 1, 20, 33, and 41 of the instant application are directed towards a gaming

method and system that allows a "player to add value to a gaming device via a voucher" and a

process to determine "the number of full and partial credits represented by the value" and

"allowing the player to play a game on the gaming device for partial credits and full credits".

Claims 1-6 of patent '559 are directed towards a gaming method and system that "determines a

redemption value of a voucher", "calculating a total number of credits available for game play

using the redemption value and the credit value, the total number of credits available for game

play comprising a partial credit", and "allowing game play with full and partial credits

simultaneously". The claims of the instant application and the claims of US patent '559 are

restatements towards the same subject matter. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to simply re-word the claims of patent '559

with common variations in terms and phrasing to derive the claims of the instant application.

Furthermore, there is no apparent reason why applicant was prevented from presenting

claims corresponding to those of the instant application during prosecution of the application,

which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1, 3-14, 17-20, 25-31, 33-35, 37, 39-41, and 44-46 are rejected under 35

U.S.C. 103(a) as being unpatentable over Wilms (US 5,277,424) and Congello, Jr. (US

6,296,569 B1), and further in view of Rowe et al. (US 6,682,421 B1).

Regarding claims 1, 20, 33, and 41, Wilms teaches a gaming device and method of

operation that allows a player to add a value to a gaming device. The device is able to process

the insertion of multiple denominations of bills and coins (*see col. 2: ln 25-35*). Wilms teaches a

gaming system that converts the entered currency into a credit equivalent value. This is then

displayed on the game machine representative of a full and partial credit value added by the

player. This is provided by dividing the value added by the player by the credit value selected by

the player to derive a whole value number and setting the whole value result in the CREDITS

[16] indicator (*see col. 3: ln 1-17, col. 4: ln 22-33*). Wilms also teaches the ability of tracking

the fractional units in its RESERVE indicator [18]. Additionally, Wilms teaches a controller that

is in communication with the value acceptor so that the machine may be notified whether enough

credits exists for a player to operate the machine (*see col. 7: ln 59-col. 8: ln 2*). Furthermore,

Wilms allows the player to select the denomination to be represented for a wager. Wilms

teaches that a game of wagering (*ie: five-card draw poker*) as a possible embodiment where the

player may make a wager and play the gaming device (*see col. 2: ln 42-54*). However, Wilms

lacks in teaching the ability to wager both partial credits and full credits and allowing a player to

add a value to a gaming device via a voucher.

In an analogous gaming reference, Congello, Jr. teaches the implementation of a user to

purchase fractional denomination game tickets. Congello teaches the ability to allow a user to

place any denomination bets, which will result in a fractional payoff in comparison of a typical

full credit bet system. Congello teaches that one would be motivated to implement this type of

system in order to allow customers to convert change or loose coins into game tickets. This

would allow users that do not have a desire to play a large denomination to participate in a

lottery type game therefore increasing the amount of money that is played on the game machine

(*see col. 1: ln 60-col. 2: ln 7*). Therefore it would have been obvious to one of ordinary skill in

the art at the time the invention was made to incorporate the fractional denomination betting

taught in Congello, Jr. with Wilms to create a gaming machine that allowed fractional betting.

However, the combination of Wilms and Congello is still silent with regards to "allowing a

player to add value to a gaming device via a voucher".

In an analogous game system, Rowe teaches the ability for a player to add a value to a

gaming device via a ticket or voucher (*see ticket reader and card reader [345, 340] of Fig. 3 and

the related description thereof*). It has become a common occurrence in the video game arts for

vouchers and tickets to be used in the place of cash in order to provide a more accurate tracking

method for the casinos and security for the players. One would be motivated to provide the

service of using a voucher as opposed to only cash means in order to provide the benefits of

security to the users. Therefore it would have been obvious to one of ordinary skill in the art at

the time the invention was made to incorporate Rowe et al. with Wilms and Congello to use

vouchers or tickets to add a value to a gaming device.

Regarding claims 4-6, Wilms teaches a method of wagering wherein a player may select

the credit value. Wilms states that if the player's account has less than the credit value the player

is prompted to either change the credit value to a lower denomination or to add money to the

users account (*see col. 7: ln 59-col. 8: ln 15*).

Regarding claim 7-9, 27-29, 40 and 45-46, Wilms teaches a gaming machine wherein the partial credit value is stored to be displayed by the RESERVE indicator [18]. Wilms also states that the full and partial credits are displayed to the player through CREDIT [16] and RESERVE [18] indicators. The player may wager these credits at any time (*ie: through the variability of modifying the wagered value*) (*see col. 6: ln 40-67, col. 7: ln 10-56*).

Regarding claims 10-11, Wilms teaches the partial credits as decimals which are inherently fractions as decimals are a linear array of digits that represent a real number. For example, decimals typically indicate a negative power of 10 (*ie: $10^{-1} = 0.1 = 1/10$*) (*see Figs. 3-5 and the related description thereof*).

Regarding claims 12-13, and 30, Wilms' gaming device allows for the user to change the first selected credit value to a second credit value between rounds of play in the game of change. The gaming device constantly readjusts the CREDIT and RESERVE indicators to correspond with the new value per credit (*see col. 6: ln 25-39*).

Regarding claims 17-19, 25, and 44, Wilms comprises setting an increment rate by which the player can increase and decrease the credit value. Additionally, the value added by a player is in a first currency and the full and partial credits may be represented in a second currency (*see col. 7: ln 30-57*). Furthermore, Wilms allows a value to be added by the player in a first currency and then is divided into a full and partial credit value as a representative version of the second currency value (*see col. 7: ln 30-57*). Furthermore, Wilms allows a value to be added by the player in a currency and the partial credits have a value other than a standard denomination in which the currency is issued or an integral multiple thereof.

Regarding claim 26, Wilms teaches a default credit value that is assigned if the player

does not define a new credit value (*see col. 5: ln 28-46*).

With regards to claim 3 and 31, Wilms teaches a game machine that allows for a one to

one exchange in currency to take place in a gaming machine having variable denominations to

wager and calculates the monetary value into a CREDITS (*ie: full credits*) and RESERVES (*ie:*

partial credits) value. AS disclosed in Wilms these partial credits may also yield winnings and

may be wagered (*ie: when the denomination is lowered below the credit value*) (*see col. 6: ln 3-*

39). However, although Wilms allows the ability to change the denomination and allows the

RESERVE credit to be wagered it lacks in teaching the ability for one to vary the RESERVE

amount wagered beyond the pre-existing limitations created by the programmer of the gaming

device.

However, in an analogous gaming patent, Congello teaches the ability to offer a

fractional denomination game wager. Congello teaches that one would be motivated to allow the

use of partial credits in order to allow for the user to fully utilize their resources when using a

wagering system (*see col. 5: ln 5-17*). Therefore it would be obvious to one of ordinary skill in

the art at the time of the invention to include the teachings of Congello with Wilms to

incorporate partial credit wagering.

With reference to claims 14, and 34-35, Wilms teaches a gaming machine where the full

credits and partial credits are modified depending on the value of the credit as selected by the

user. As a result the player may wager the full credits and partial credits at any time depending

on the selection of the user (*see col. 5: ln 28-53*). One would be motivated to offer selections in

the wagering denominations to allow for all currency to be adapted in order to allow for the user

the ability if they wish to wager their full amount associated with the player account. As disclosed in Wilms the denominations can easily be programmed to fit the appropriate needs of the system to increase or decrease by predetermined amounts. Additionally, Wilms indicates that the predetermined amounts to increase and decrease could be programmed into the system to adjust by a predetermined factor. Wilms offers the adaptability of this feature in order to offer different ranges for example from 5 cents to $1.00 which if multiplied by a factor of 100 could adapt it to $5.00 to $100.00. If one were limited to only 20 cents to wager the system disclosed in Wilms could be multiplied by a factor of 4 to provide a range of $0.20 to $4.00 (*see col. 6: ln 40-col. 7: ln 15*). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to allow the system to be programmed so that all of the partial credits and for non-standard denominations to be wagered (*see col. 7: ln 30-50*).

Claims 37 and 39, Wilms teaches a game machine that comprises a casino marker acceptor and dispenser, which is analogous in the gaming art to a voucher. Therefore it would be a simple matter of design choice for one of routine skill to modify Wilms to allow the use of voucher certificates as opposed to casino markers. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wilms in order to allow for a user to implement a voucher accepter and printer instead of the casino markers used (*see col. 5: ln 4-27*).

Claims 15-16, 23-24, 36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilms and Congello, Jr. and Rowe et al. as applied to claims above, and further in view of Skratulia (US 5,690,335).

With reference to claims 15-16, 23-24, 36 and 43, Wilms and Congello and Rowe et al. teach a game machine that accepts vouchers and allows the use of full and partial credits in a wagering game as discussed above and incorporated herein. However, Wilms and Congello lack in specifically disclosing a maximum and minimum credit value for wagering within its game machine. However, it is understood in the gaming arts that casinos will typically setup minimum and maximum wagers in order to cater to the target clientele. In Skratulia, he teaches the use of an analogous method of playing a wagering game (*see col. 3: ln 20-40*). Skratulia discloses that it would be an obvious matter of design choice for the establishment to set the maximum amount and that gaming machines are typically adaptable and may be modified to fit the maximum and minimum bets that the casino would like to implement in their machines. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Skratulia with Wilms in order to allow the gaming machine in Wilms to include a minimum and maximum wager amount.

Claim 37, Wilms discloses a controller that is configured to allow the game operator to set an increment value by which the credit value can be raised or lowered (*see col. 7: ln 30-50*).

Response to Arguments

Applicant's arguments filed 5/8/06 have been fully considered but they are not persuasive. Applicant's representative argues that neither Wilms nor Congello, either alone or in combination teach, suggest, or disclose a gaming device that allows a player to add value to the gaming device via a voucher and to allow game play using full and partial credits. Examiner respectfully disagrees. Wilms does in fact not teach the adding of a value using a voucher

because at the time the invention was made, voucher systems were not common in the gaming

arts. Therefore the specification of Wilms is not directed towards the incorporation of a voucher

system. However, it does teach the ability to track and use full and partial credits and allows a

user to add value to a gaming device. Examiner directs the applicant to Rowe as a reference that

teaches about accepting tickets or voucher devices as combined with Wilms and Congello in the

above rejection. Additionally, Examiner directs the applicant to Congello for the ability to wager

partial credits, since Congello teaches a wagering game that allows the purchase of fractional

denomination lottery tickets and pays a winner a fractional amount based on the amount the

player has wagered.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Luciano et al. (US 6,500,067 B1) – Voucher Gaming System.

Chowdhury (US 6,623,357 B2) – Paper Token and Complementary Coupon Dispenser.

Weil et al. (US 6,824,464 B2) – Prepaid Account Lottery System and Method.

Any inquiry concerning this communication or earlier communication from the examiner

should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can

normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Robert P Olszewski can be reached at (571)-272-6788.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications
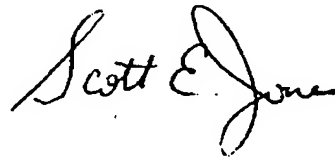
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RH

August 18, 2006

SCOTT JONES
PRIMARY EXAMINER